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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,365	11/25/2003	Osamu Omori	81754.0106	4601
26021	7590	12/01/2004	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			VU, HUNG K	
			ART UNIT	PAPER NUMBER
			2811	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/722,365	Applicant(s) OMORI, OSAMU	
	Examiner Hung Vu	Art Unit 2811	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/12/04, 5/24/04</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Invention of Group I, Claims 12-23, in the reply filed on 09/07/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's election without traverse of Invention of Group I, Claims 12-23, in the reply filed on 09/07/04 is acknowledged.

Claims 1-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 09/07/04.

### ***Specification***

2. The disclosure is objected to because of the following informalities: On page 14, line 18, "optical deice" should be changed to "optical device" for clarity.

Appropriate correction is required.

### ***Claim Objections***

3. Claims 17 – 23 are objected to because of the following informalities:

In claims 17 – 22, line 1, "a semiconductor" should be changed to "the semiconductor" for clarity.

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In claim 23, line 6, “the an optical” should be changed to “an optical” for clarity.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 – 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 – 15 are depend on the non-elected claim 1, it is unclear how to determine the scope of the claimed invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12 – 15, insofar as in compliance with 35 USC 112, are rejected under 35 U.S.C. 102(b) as being anticipated by Tachibana (PN 5,889,323).

Tachibana discloses, as shown in Figures 1-6C, a semiconductor device comprising:

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forming a cover (14) onto a semiconductor substrate (upper portion of 13) so as to place a surface of the cover that includes a portion defining a first opening, face to face on a surface of the semiconductor substrate that includes an electrode (12);

forming an adhesive (15,16) inside the first opening.

With regard to claim 13, Tachibana discloses the device further comprising a support member (lower portion of 13) attached to the semiconductor device.

With regard to claim 14, Tachibana discloses the device further comprising a circuit substrate (portion under the pad 17) that is electrically coupled to the electrode of the semiconductor device.

With regard to claim 15, Tachibana discloses an electronic equipment comprising the semiconductor device.

6. Claims 12 – 23, insofar as in compliance with 35 USC 112, are rejected under 35 U.S.C. 102(b) as being anticipated by Salatino (PN 5,798,557).

Salatino discloses, as shown in Figures 1-12, a semiconductor device comprising:

forming a cover (260) onto a semiconductor substrate (upper portion of 202) so as to place a surface of the cover that includes a portion defining a first opening, face to face on a surface of the semiconductor substrate that includes an electrode (242);

forming an adhesive (262,236) inside the first opening.

With regard to claim 13, Salatino discloses the device further comprising a support member (lower portion of 202) attached to the semiconductor device.

With regard to claim 14, Salatino discloses the device further comprising a circuit substrate (portion under 250) that is electrically coupled to the electrode of the semiconductor device.

With regard to claim 15, Salatino discloses an electronic equipment comprising the semiconductor device.

With regard to claim 16, Salatino discloses, as shown in Figures 1-12, a cover (260) for a semiconductor device comprising:

- a portion defining a first opening (264,406) on a surface of the cover;
- a portion defining a second opening (263,265,404) on the surface of the cover;
- a translucent portion (290,298) in at least the portion defining the second opening,

wherein the first opening is formed along a circumference of the second opening, and the second opening is formed so as to include an optical unit (242) inside of the second opening and wherein the optical unit of the semiconductor substrate that includes the optical unit is sealed.

With regard to claim 17, Salatino discloses the first opening is formed so as to surround the second opening.

With regard to claim 18, Salatino discloses the cover further comprising a portion defining a third opening (404) on the surface that includes the portion defining the first opening and the portion defining the second opening and wherein the third opening is formed along a circumference of the second opening.

With regard to claim 19, Salatino discloses the first opening is formed between the second opening and the third opening.

With regard to claim 20, Salatino discloses the cover further comprising a portion defining a through-hole (404) that extends from a back side of the surface that includes the portion defining the first opening to inside the first opening.

With regard to claim 21, Salatino discloses the cover further comprising:

- a portion that is formed in line along the cover;
- a slit that is formed in line on the portion of the first opening that is formed in line.

With regard to claim 22, Salatino discloses the first opening is formed so as to penetrate from one side of the cover to the other side of the cover.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung K. Vu whose telephone number is (571) 272-1666. The

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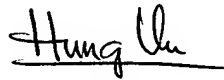
examiner can normally be reached on Mon-Thurs 6:00-3:30, alternate Friday 7:00-3:30, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie C. Lee can be reached on (571) 272-1732. The Central Fax Number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Vu

November 22, 2004

A handwritten signature in black ink, appearing to read "Hung Vu", written over a horizontal line.

Hung Vu

Patent Examiner